

REMARKS

Upon entry of the instant Amendment, claims 1-14, 20 and 33-39 will be pending in the application. By this amendment, claims 1, 5, 7, 9, 10, 13 and 14 will have been amended and claims 33-39 have been added. Support for the amendment to the claims and new claims 33-39 is provided in at least the figures and paragraphs [0024] and [0027] – [0029] of the instant published patent application 2005/0207879. No new matter is added. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Allowed Claims

Applicants appreciate the indication that claim 5 contains allowable subject matter. As Applicants have presented claim 5 in independent form, Applicants submit that at least claim 5 should now be indicated to be allowed.

Furthermore, by the instant amendments, Applicants submit that all of the pending claims are in condition for allowance and that the rejections under 35 U.S.C. §§ 112, 102 and 103 are now moot and should be withdrawn.

Claim Objection

Claim 13 was objected to because it contains a typographical error, i.e., because it recites the term “plat” instead of “plate”.

By this Amendment, claim 13 has been amended in order to resolve this basis of objection.

Accordingly, Applicants respectfully request that the above-noted objection be withdrawn.

35 U.S.C. § 112, 2nd Paragraph

Claim 2 was rejected as being indefinite because, the Examiner alleges, it further defines the product recited in claim 1 as mail pieces.

Applicants respectfully disagree with this basis of rejection and the Examiner's assertions. Applicants submit that further defining of the term product as mail pieces in claim 2 does not render the claims unclear, and the Examiner has not demonstrated otherwise.

As the Examiner well knows, the definiteness of a claim is measured from the vantage point of one having ordinary skill in the art. Applicants submit that one having ordinary skill in the art would have no difficulty understanding the invention claimed in claim 2, and the Examiner has not shown otherwise. Moreover, the fact that one or more claim features is not given patentable weight by the Examiner does not *per se* render that claim indefinite.

Accordingly, Applicants respectfully request that the above-noted rejection be withdrawn.

35 U.S.C. § 102 Rejections

Over Ueda

Claims 1-4, 7, 8, 10 and 14 were rejected under 35 U.S.C. § 102(b) for being allegedly anticipated by U.S. Patent No. 5,427,226 to UEDA et al. This rejection is respectfully traversed.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, a single prior art reference must disclose each and every element as set forth in the subject claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that a *prima facie* case of anticipation cannot be established because UEDA fails to teach each and every element of the claims.

More particularly, amended independent claim 1 recites, *inter alia*,

an additional plate mechanism configured to move the product positioned between the other plate mechanism and the plate mechanism so as to cause the product to press against the plate mechanism.

Applicants submit that UEDA does not disclose or even suggest at least these features. Applicants acknowledge that UEDA discloses a system which utilizes a conveyor 11, a door 47 which supports product B, and what could arguable be characterized as a moveable plate mechanism 43 (see Figs. 2a-3b). However, Applicants submit that UEDA does not disclose, or even suggest, an additional plate mechanism configured to move the product positioned between the additional plate mechanism and the plate mechanism so as to cause the product to press against the plate mechanism. To the contrary, Figs. 2a, 2b and 3a clearly illustrate that the members 43 and 44 presses against the product B, and not vice versa.

Thus, Applicants respectfully submit that independent claim 1, and claims 2-4, 7, 8, 10 and 14, which depend from claim 1 are allowable.

Accordingly, Applicants respectfully request that the above-noted rejection under 35 U.S.C. § 102(b) should be withdrawn.

Over Pena

Claims 1-3, 6-12 and 14 were rejected under 35 U.S.C. § 102(b) for being allegedly anticipated by U.S. Patent No. 5,779,432 to PENA. This rejection is respectfully traversed.

Applicants respectfully submit that a *prima facie* case of anticipation cannot be established because PENA fails to teach each and every element of the claims.

Again, amended independent claim 1 recites, *inter alia*,

an additional plate mechanism configured to move the product positioned between the other plate mechanism and the plate mechanism so as to cause the product to press against the plate mechanism.

Applicants submit that PENA does not disclose or even suggest at least these features. Applicants acknowledge that PENA discloses a system which utilizes a conveyor, a door 66 which supports product 12, and what could arguable be characterized as a moveable plate mechanism 58 (see Figs. 2b-2d) However, Applicants submit that PENA does not disclose, or even suggest, an additional plate mechanism configured to move the product positioned between the additional plate mechanism and the plate mechanism so as to cause the product to press against the plate mechanism. To the contrary, Fig. 2c clearly illustrates only one so-called plate

mechanism 58, i.e., no other plate mechanism is utilized, much less, one that is configured to move the product positioned between the other plate mechanism and the plate mechanism so as to cause the product to press against the plate mechanism.

Thus, Applicants respectfully submit that independent claim 1, and claims 2-3, 6-12 and 14, which depend from claim 1 are allowable.

Accordingly, Applicants respectfully request that the above-noted rejection under 35 U.S.C. § 102(b) should be withdrawn.

35 U.S.C. § 103 Rejection

Claims 13 and 20 were rejected under 35 U.S.C. § 103(a) for being allegedly unpatentable over PENA alone. This rejection is respectfully traversed.

The Examiner acknowledges that PENA fails to disclose, among other things, the features recited in the above-noted claims. However, the Examiner explains, without citing any prior art, that such features would have been obvious. Applicants respectfully submit that a *prima facie* case of obviousness has not been established as the applied references fail to teach each and every element of the claims.

Applicants submits that PENA fails to disclose or suggest the combination of features recited in at least independent claim 1, as noted above. Applicants also submit that no proper modification of PENA discloses or suggests the combination of features recited in at least claim 1.

As explained above, PENA lacks any disclosure or suggestion with regard utilizing an additional plate mechanism, much less, one that is configured to move the

product positioned between the additional plate mechanism and the plate mechanism so as to cause the product to press against the plate mechanism. Nor has the Examiner demonstrated otherwise.

Moreover, in addition to failing to disclose the combination of features recited in the above-noted claim 1, Applicants submit no proper modification of PENA discloses or suggests the combination of features recited in dependent claims 13 and 20, which also respectfully contain all of the features of claim 1.

With regard to the Examiner's assertions of official notice in support of the instant rejection, Applicants remind the Examiner that MPEP 2144.03 specifically explains that "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." Accordingly, Applicants respectfully request that the Examiner produce documentary evidence to support the Examiner's assertions of official notice.

Accordingly, Applicants respectfully submit that the above-noted rejection under 35 U.S.C. § 103(a) should be withdrawn.

New Claims are also Allowable

Applicants submit that the new claims 33-39 are allowable over the applied art of record. Specifically, claims 33 and 34 depend from claim 1 which is believed to be allowable. Additionally, claims 33-39 recite a combination of features which are clearly not disclosed or suggested by the applied art of record. Accordingly, Applicants

respectfully request consideration of these claims and further request that the above-noted claims be indicated as being allowable.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Respectfully submitted,
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